

Application No.: 10/766,138
Amdt dated: March 22, 2010
Reply to Office action of December 22, 2009

REMARKS/ARGUMENTS

This response is filed in reply to the Office action mailed December 22, 2009. Claims 51 and 62 have been amended. Claims 1-50 and 66 are canceled without prejudice, disclaimer and/or in view of the rejections. New claims 67-77 have been added. Claims 51-65 and 67-77 are pending in the application.

Double Patenting

On page 3, claims 51-66 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,534,317. Applicant respectfully traverses this rejection. Applicants however respectfully forego filing a Terminal Disclaimer in compliance with 37 C.F.R. §§ 1.321(c) or 1.321(d) at this time and choose instead to wait until it is known which claims will proceed to issuance in this case and in what form they are allowed.

Claim Rejections – 35 USC § 102

On page 3, claims 51, 53-57, and 59-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Keith et al. (US 5,888,436). On page 4, claims 51-55, 57 and 59-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Berg et al. (US 5,792,116). Also, on page 4, claims 51-53, 55-58, 60, 62, 63 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (US 6,464,632). On page 5, claims 51, 53, 55-58, 62, 63 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutton (US 5,472,435). Applicant respectfully traverses these rejections.

To be anticipating, a prior art reference must disclose each and every limitation of the claimed invention, the prior art must be enabling, and the prior art reference must describe the claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339 (Fed. Cir. 2000).

Independent claim 51 as amended provides (emphasis added):

A method of manufacturing a kink-resistant thin-walled tube having a length with different characteristics, comprising:

- coating a mandrel with a first layer of plastic material;
- placing a spring reinforcement over the first layer;
- coating the spring reinforcement with a second layer of plastic material to form a spring-reinforced tube;
- modifying the mandrel's size after the spring-reinforced tube is formed.

Independent claim 62 as amended provides (emphasis added):

A method of manufacturing a kink-resistant thin-walled tube having a length with different characteristics, comprising:

- coating a mandrel with a first layer of plastic material, the mandrel having a width;
- placing a spring reinforcement over the first layer;
- dipping the spring-reinforced first layer in a solvent based solution to form a second layer of the tube; and
- modifying the width of the mandrel after the second layer of the tube is formed, wherein the mandrel is a multiple-part mandrel.

As recited in independent claims 51 and 62, the methods of manufacturing of a kink-resistant thin-walled tube provides the modifying of the mandrel's size or width which is particularly useful, e.g., for the removal of the mandrel once the thin-walled tube is formed without having to manipulate the formed tube and/or potentially damaging the tube. The Office action and the cited references (Keith, Berg, Taylor and Sutton) do describe mandrels but they are all silent as to mandrel's size or width being modified after the tube is formed as provided in claims 51 and 62. Also, independent claim 62 now incorporates non-rejected claim 66.

Therefore, Applicant respectfully submits that Keith, Berg, Taylor and Sutton fails to disclose each and every element of independent claims 51 and 62 and thus these

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references cannot anticipate claim 51 and 62. Claims 51 and 62 therefore are believed to be allowable over the cited references and thus Applicant respectfully requests reconsideration and withdrawal of the rejections. Applicant also respectfully submits that **Claims 52-61** which depend from Claim 51 are also allowable as depending from an allowable claim. Likewise, **Claims 63-65** which depend from claim 62 are also allowable as depending from an allowable claim. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

Claim Rejections – 35 USC § 103

On page 6, claims 59, 61, 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US 6,464,632) as applied to claims 51-53, 55-58, 60, 62, 63 and 65 above, and further in view of either of Keith et al. (US 5,888,436) or Chiu et al. (US 6,540,734) or Kolobow (US 5,429,127) or Crowley (US 5,840,031).

Also, on page 6, claims 59, 61, 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton (US 5,472,435), as applied to claims 51, 53, 55-58, 62, 63 and 65 above, and further in view of either of Keith et al. (US 5,888,436) or Chiu et al. (US 6,540,734) or Kolobow (US 5,429,127) or Crowley (US 5,840,031). Applicant respectfully traverses these rejections.

In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the art in making a *prima facie* case of obviousness. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must be found in the cited references or must be known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As previously noted, independent claims 51 and 62 have been amended to provide the modifying of the mandrel's size or width which is particularly useful, e.g., for the removal of the mandrel once the thin-walled tube is formed without having to

manipulate the formed tube and/or potentially damaging the tube. The Office action and the cited references (Keith, Taylor and Sutton) do not describe or suggest these features. The other references, Chiu, Kolobow and Crowley, do not cure the deficiencies of Taylor, Sutton and Keith.

Claims 59 and 61 depend from independent claim 51 and **claim 64** depends from independent claim 62. As indicated above, Applicant believes that independent claims 51 and 62 are allowable over the cited references for the reasons stated. Thus, since claims 59 and 61 depend from independent Claim 51 and contain additional limitations that are patentably distinguishable over the references of record, claims 59 and 61 are also believed to be patentable. Likewise, since claim 64 depends from independent claim 62 and contains additional limitations that are patentably distinguishable over the references of record, claim 64 is also believed to be patentable.

Additionally, regarding claims 61 and claim 62 that now incorporates claim 66, these claims provide the mandrel is a multiple-part mandrel. The action indicates that "Keith (Figure 1C), Chiu (Figure 21D), Kolobow (col. 12, lines 32-36), and Crowley (col. 10, lines 60-67) teach that in the art of producing it is known to employ tapered mandrels/mandrels having a variety of section (i.e. multiple parts)." However, these references describe a single piece mandrel and not a mandrel with multiple parts. For example, Keith, in col. 5, lines 15-17, describes "a new mandrel 30 consisting of a continuous length of wire" and Chiu, in col. 31, lines 47-50, describes "a tapered mandrel is formed by having a gradual taper of one end of the mandrel (22a or 22aa) while keeping the round cross-sectional shape concentric to the mandrel." Kolobow, in col. 6, line 68 to col. 7, line 2, at most describes a "cylindrical mandrel may be made of any material having sufficient strength to provide tube for the tubing, preferably a steel rod" and Crowley, in col. 10, lines 65-66, at most describes a "mandrel, which may be tapered or stepped, or have a constant cross-sectional diameter". Accordingly, Keith, Chiu, Kolobow and Crowley at most describe a single piece mandrel and do not describe or suggest a multiple-part mandrel.

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Accordingly, based on at least the foregoing reasons, a prima facie case of obviousness has not been established and hence reconsideration and withdrawal of the rejections of claims 59, 61 and 64 in view of their respective asserted rejections are respectfully requested.

New Claims

New **claims 67-77** describe other aspects of the invention. For example, new claim 67-77 provides the modification and/or application of one or more mandrels to manufacture a kink resistant thin-walled tube. The cited references do not describe or suggest such methods of manufacturing of a kink resistant thin-walled tube with the recited features in new claims 67-77. Also, since claims 67 and 69-71 depend from independent claims 51 and thus incorporate the features recited in corresponding claim and contain additional limitations that, when considered as a whole are patentably distinguishable over the references of record, claims 67 and 69-71 are believed to be patentable. Likewise, since claim 68 depends from independent claim 62 and thus incorporate the features recited in the corresponding claim and contains additional limitations that, when considered as a whole are patentably distinguishable over the references of record, claim 68 is believed to be patentable.

New claims 67-77 also depend from a claim readable on the elected invention and/or are directed to manufacturing a kink resistant thin-walled tube. Thus, new claims 65-66 are believed readable on the elected invention. If, however, based on this amendment the Examiner believes a different election/restriction requirement is required and/or selection of claims, Applicant reserves the right to change/traverse the election of species and claims directed thereto. Additionally, the new claims find full support in the original specification. Accordingly, Applicant submits that no new matter has been added.

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Conclusion

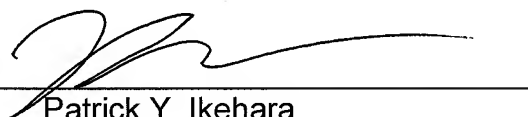
Although the present paper may include a combination of alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding that previously pending claims in this application are not patentable over the cited references. Rather, any alterations and/or characterizations are made to facilitate prosecution of this application. Applicants reserve the right to pursue any previously pending, or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or in any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Applicants submit that all of the Examiner's rejections have been addressed and overcome, and that all claims are allowable over the art of record. Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. Should the Examiner believe that any outstanding issues are resolvable in an Examiner's Amendment, the Examiner is invited to contact the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 01-2215.

Sincerely

APPLIED MEDICAL RESOURCES

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